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EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,425

Applicant(s)

RHOADES, DEAN

Examiner

Frank I Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7,21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2,3,5,7,21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims to include at least about twenty three percent by weight moisturizer and in claims 5,7,23 at least 35 percent by weight of the composition contains a plurality of abrasive particles. Claims 5, 7 continue to recite the end point of the micron size as being "124 microns.

In order to arrive at the phrase "at least about twenty three percent by weight a moisturizer" Applicant recites to a mixture of Safflower Oil, Octyl Palmitate and Propylene Glycol (Examiner notes that Applicant in its argument indicates that the combination adds up to 29.3%, however, the correct amount is 22.9%. Applicant does not cite to anywhere in the Specification which includes about 23% of a single agent which is a moisturizer. Safflower oil, octyl palmitate and propylene glycol are not identified as moisturizers in the Specification. They are disclosed as being included in a moisturizer (See Paragraph 0014 of the Specification).

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Further, Applicant in responding to the prior art rejections argues that the definition of “moisturizer” is set forth in paragraph 0014 of the Specification. Said paragraph does not appear to recite a definition, only Applicant’s belief that “[m]oisturizers are believed to reduce water loss from the skin and draw moisture from inner skin layers up into the outer skin layer”. Even if the same constitutes as definition, there is nothing in the Specification which indicates that safflower oil, octyl palmitate and propylene glycol, each alone, have the ability to act as a barrier and draw moisture. As such, the Specification does not appear to provide a written description for the claim limitation above.

In addition, the range of at least about twenty three percent with respect to the moisturizer and the range of at least 35% with respect to corundum clearly encompasses embodiments which are outside the disclosed ranges set forth in paragraphs 0016 and 0017 of the Specification. As such, said limitations appear to constitute new matter. See *In re Wertheim*, 191 USPQ 90,97 (CCPA 1976) (*Wertheim I*) (range of “at least 35%” read literally on embodiments outside of the ranges described in the application); *PIN/NIP Inc. v. Platte Chemical Co.*, 64 USPQ2d 1344, 1352-1353 (CAFC 2002) (lack of written description for sequential administration where examples disclosed mixtures).

There does not appear to be any disclosure in the Specification which sets forth the average particle size being 124 microns and Applicant offers no reason why 124 microns was chosen as opposed to some other number. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. See, e.g., *In re Lukach*, 169 USPQ 795 (CCPA 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); *In re Smith*,

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173 USPQ 679, 683 (CCPA 1972) (a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads).

Applicant's reliance on Wertheim I is misplaced. The court in Wertheim I specifically stated that they were not creating a rule applicable to all description requirement cases involving ranges. Examiner is not disputing that Applicant has sufficient disclosure for 34 microns in the range of 34 microns to 124 microns as set forth in claims 5, 7 of the present application. The issue is whether there is written description for the end point of 124 microns. Applicant herein appears to have arbitrarily chosen a number which is impermissible. See *In re Rodman*, 106 USPQ 142, 144, 145 (CCPA 1955). Applicant quotes extensively from Wertheim I, however, Wertheim I also indicates that "where it is clear, for instance, that the broadly described range pertains to a different invention than the narrower (and subsumed) claimed range, then the broad range does not describe the narrower range." See Wertheim I at pg. 98. The Court concluded that "in the context of *this* invention, in light of the description of the invention as employing solids contents within the range of 25-60% along with specific embodiments of 36% and 50%, we are of the opinion that, as a factual matter, persons skilled in the art would consider processes employing a 35-60% solids content range to be part of appellants' invention and would be led by the Swiss disclosure so to conclude as a part of appellants' invention." See Wertheim I at pg. 98. As such, the ruling in Wertheim I was based on the fact there was a specific embodiment of 36% and a disclosed range of 25% to 60% to support the claimed range of 35% to 60%.

Contrary to Applicant's arguments, *In re Wertheim*, 209 USPQ 554 (CCPA 1981) (Wertheim II) is directly on point. In Wertheim II, the Court disagreed with the Board's apparent determination that because the range of 35% to 60% was within the broad disclosure of

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the parent case said range in the continuation-in-part case did not constitute new matter. The Court held that said limitation did constitute new matter and was relevant because said limitation avoided the prior art. Wertheim II at pg. 565. Applicant, in this case, specifically amended the claims to recite less than 125 microns to avoid the prior art. Remarks (5/16/2003), pgs 5, 6). As such, the recitation of "124 microns" appears to be a different invention than the broader end point of "556 microns". As such, the recitation of "124 microns" is not supported by the written description.

Claims 1-3,21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant amended the claims to recite "about twenty three percent" in order to avoid the prior art disclosure of "about 20%" set forth in McAtee, discussed below. However, Applicant does not indicate what amount is encompassed by the term "about twenty three percent". As such, the claims are indefinite. See *Amgen Inc., v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016, 1030,1031 (CAFC 1991).

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,5,7,21,22,23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Messenger (US Pat. 6,290,976) for the reasons of record set forth in the prior Office Action.

Messenger was cited in the prior Office Action and is incorporated herein to avoid repetition.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant's rule 131 affidavit is insufficient to overcome the rejection. A rule 131 affidavit cannot be used where the US Patent or US Patent Application claims the same invention. See MPEP 715 [R-1]. The term "same invention" includes an obvious variation. An obvious variation of the claims of the cited US Patent, include that set forth in Example 1, which includes 40% corundum and 56% mineral oil which meets Applicant's amendment of at least about 23% and at least 35% of corundum. One of ordinary skill in the art would expect that the composition in example 1 would be a suitable embodiment of the claims 1-7 of said patent. Since Applicant's arguments are solely related to the rule 131 affidavit, Examiner maintains the rejection herein.

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Claims 1,2,21,22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lee et al. (US Pat. 6,294,179) for the reasons of record set forth in the prior Office Action.

Lee et al. was cited in the prior Office Action and is incorporated herein to avoid repetition.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant's claim does not define what constitutes the moisturizer and Applicant's Specification appears to indicate that the moisturizer can contain a combination of substances (Paragraphs 0014,0015). The term "moisturizer" means a cosmetic lotion or cream applied to the skin to counter dryness. See The American Heritage Dictionary of the English Language, Fourth Edition (2000). The carrier in Lee et al. appears to fall within the scope of said definition as it is in the form of a cream or lotion and contains water and it is applied to the skin. Applicant argues that it is unable to discern any part of Lee that teaches or suggests a moisturizer that is about 23% percent of the base. However, as indicated above, a moisturizer may be a single compound or a combination of compounds. For example, water clearly provides moisture and is present in an amount greater than 20% which in combination with or without the surfactants, hectorite and/or xanthan gum appears to fall within the scope of the limitation moisturizer .

Applicant argues that water is outside the scope of moisturizer as defined in the Specification. However, paragraph 0014 does not define the term "moisturizer" but only indicates Applicant believes that moisturizers reduce water loss from the skin and draw moisture from inner skin layer up into the outer skin layer. If said language constitutes a definition than propylene glycol, safflower oil and octyl palmitate are not moisturizers based on said definition.

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The Specification does not describe safflower oil, octyl palmitate and propylene glycol as each having both barrier functions and drawing of water functions. As such, paragraph 0014 cannot be read to exclude water, regardless of whether water is described as being moisture or providing moisture, from being part of a moisturizer which is composed of several components, including said water, to form or in the form of a cosmetic lotion or cream which counters skin dryness.

Examiner notes that Applicant has admitted that water is moisture (Remarks (9/16/2004) at pg. 10), as such, application to the skin will moisturize the skin and, thus, water is a moisturizer. See Merriam-Webster's Collegiate Dictionary (10th Ed. 1998), pg. 749. As such, in this context, a moisturizer can be a specific agent, i.e. water, or a mixture of agents wherein the mixture includes water. Therefore, the prior art composition appears to fall within the scope of the claimed invention.

With respect to the limitation "where the composition may be left on the skin after application", this is an intended use. In fact, it is by the terms of its language an optional intended use. In any case, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The burden is on Applicant to show that the prior art composition is not capable of being left on the skin after application.

There is nothing in the Specification which indicates that the above limitation is a property analogous to describing the composition as being non-toxic. In fact, the Specification does not even set forth said limitation. Paragraph 0032 indicates that the composition is worked

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into the skin and that the user wipes off any unabsorbed portion of the composition and may optionally rinse or cleanse the area. As such, the entire composition as applied is not left on the skin. In any case, given that the composition in Lee is intended to be applied to the skin (See Lee, Column 5, Column 6, lines 1-20), Applicant still has the burden of showing that the composition in Lee is toxic if left on the skin. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978).

Claims 1-3, 21,22,23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saperstein (US Pat. 3,092,111) or Stiefel (US Pat. 4,957,747) for the reasons of record set forth in the prior Office Action.

Saperstein and Steifel were cited in the prior Office Action and the same are incorporated herein to avoid repetition. Additionally, the amount of aluminum oxide in the prior art compositions are 37.2%, 51.4% and 64.7% by weight for Saperstein (Saperstein, Column 6, lines 36-75, Column 7, Columns 13-16, claims 11,12) and 38.020 % and 52.1057% by weight for Steifel (Steifel, Column 2, Examples 1,2).

Examiner had duly considered Applicant's arguments but deems unpersuasive for the same reasons as above. Further, the Specification specifically discloses that the moisturizer can include humectants, glycerin, propylene glycol, lanolin, and silicone derivatives. The Saperstein composition contains lanolin, polyethylene glycol, glycerine and water (Column 7, lines 6-10). The Stiefel reference includes polyethylene glycol, dimethicone, glycerine and water (Column 2, lines 15-65). Applicant argues that it is unable to discern any part of the above references that teaches or suggests a moisturizer that is 23% percent of the base. However, as indicated above, a moisturizer may be a single compound or a combination of compounds. For example, water

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clearly provides moisture and is present in an amount greater than 20% and with or without the combination with the components identified above appears to fall within the scope of the limitation moisturizer . Therefore, the prior art compositions appear to fall within the scope of the claimed invention. Therefore, the prior art compositions fall within the claimed inventions.

For the same reasons as above, the limitation “where the composition may be left on the skin after application” does not appear to patentably distinguish the invention and Applicant does not appear to cite to any description in the Specification which supports Applicant’s interpretation of said limitation. Again, the burden is on Applicant to show that the prior art compositions are not capable of being left on the skin or are toxic if left on the skin.

Claims 1-3,5,7,21,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imamura et al. (US Pat. 4,284,533) for the reasons of record set forth in the prior Office Action.

Imamura et al. was cited in the prior Office Action and the same is incorporated herein to avoid repetition.

Examiner has duly considered Applicant’s arguments but deem them unpersuasive for the same reasons as above. Further, the Specification specifically discloses that the moisturizer can include humectants and propylene glycol. Imamura et al. discloses the use of glycols and glycol ethers. Further, the amount of water in the compositions is greater than about 23%. As such, the prior art teaches the use of substances which appear to meet the definition of “moisturizer” set forth in the Specification as well as the amount required in the claims. Further, for the same reasons as above, the limitation indicating that the composition may be left on the skin does not patentably distinguish the claimed invention. Also, Applicant provides no support in the Specification for its narrow interpretation of said claim limitation. In any case, limitations

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appearing in the specification but not recited in the claim are not read into the claim. See *E-Pass Techs., Inc. v. 3Com Corp.*, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003); *In re Prater*, 62 USPQ 541, 550-551 (CCPA 1969). Further, during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

With respect to the limitation “cream”, the term “cream” is not defined by the Specification. As such, the fact that the reference teaches a viscosity of less than 5000 cps does not appear to teach away from the claimed invention. Applicant has made no showing that the FDA definition was what was contemplated at the time the Application was filed. In fact, the article indicates that as of March of 2003, the definition of lotion as having a viscosity of less than 30,000 cps and cream as having a viscosity of greater than 30,000 cps were only proposed definitions and the FDA was inquiring as whether it was “reasonable” to distinguish lotions from creams based on viscosity. Applicant cites to a definition of a cream from a cosmetic ingredient’s glossary. However, said definition does not provide as indication as to what viscosity would constitute a cream as opposed to a lotion and does not state that a cream is always thicker than a lotion. Applicant citation to the article from liquidcontrol.com does not provide any evidence that a cream or lotion must have a specified viscosity. As such, there is nothing that indicates that a cream cannot have a viscosity of less than 5000 cps. See US Pat. 6,284,257 (Examples 1, 3, disclosing creams having viscosities of less than 5000 cps); See Merriam-Webster’s Collegiate Dictionary (10th Ed. 1998), pg. 272 (defines “cream” as something having the consistency of cream); Epoxy Definitions, www.primeresins.com/onlineResources/epoxy_definitions.php (2002) (viscosity of heavy cream is approximately 1,500

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centipoise). At best, one of ordinary skill in the art could conclude that creams can vary over a wide range of viscosities.

Claims 5,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. (US 2002/0090385) for the reasons of record set forth in the prior Office Action.

Fox et al. was cited in the prior Office action and the same is incorporated herein to avoid repetition. Further, Fox et al. discloses that the coated aluminum oxide to carrier ratio is within the range of about 2%-99%, preferably 50%, so long as the emulsion can be maintained and sufficient amounts of crystals are present to act as abrasers (Paragraph 0025).

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant's rule 131 affidavit cannot be used to overcome the rejection for the same reasons as above. Specifically, the cited reference is claiming the same invention as that set forth in claims 5, 7, i.e. claims 5,7 of the present application are an obvious variation of claims 1-7 of the cited reference. Claim 1 recites a crystalline emulsion for use in microdermabrasion comprising crystals coated with methicone and a carrier. Claim 3 which is dependent on claim 1 recites that crystals are selected from the group consisting of magnesium oxide and/or aluminum oxide crystals. Claim 4 recites that the crystals are a particle size of 40-200 microns. Paragraph 0013 recites that the crystals are preferably about 100-2000 microns. Claim 5 recites that the carrier is selected from the group consisting of a gel, lotion, thick solution, cream, paste or any combination thereof. Claim 6 recites that the coated crystal to carrier ratio is 1 to 2. Paragraph 0025 recites that other ratios are permissible as indicated above depending on sufficiency of abrasion and emulsion stability. Claim 7 discloses that the emulsion further comprises vitamins C or E or surfactants. As such, it would have been well within the skill of and one of ordinary

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skill in the art would have been motivated to modify the claims of cited reference by claiming a crystalline emulsion in the form of a cream, having aluminum oxide having a particle size of 40 or 100 microns where the ratio of aluminum oxide to carrier is 50%, and further containing a mineral in the form of magnesium oxide, a vitamin or antioxidant in the form of vitamin C or E and/or an emulsifier in the form of a surfactant, with the expectation that the same would be suitable for use in microdermabrasion of the skin.

Claims 1-3,21,22,23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wise (US Pat. 5,219,571) for the reasons of record set forth in the prior Office Action. .

Wise was cited in the prior Office Action and the same is incorporated herein to avoid repetition. Further, the bentonite is present in amounts of 20-60% and 50% and the lipophilic carrier is present in amounts of 20% to 80% and 40% (Column 3, Claims1,2).

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

According to Applicant's arguments a moisturizer includes a substance that acts as a barrier, such as petrolatum, mineral oil, lanolin or draws moisture from inner skin layers up into the outer skin layer, such as propylene glycol. As such, the lipophilic carriers listed in the cited reference appear to fall within the scope of the claimed moisturizer. As indicated above, "cream" is not defined by the Specification. Thus, the fact that the prior art compositions contain or may contain from 0% to 20% alcohol for purposes of modifying viscosity does not appear overcome the rejection herein. Further, Applicant's argument as to low viscosity does not overcome the rejection in that the claims do not disclose any required viscosity. As such, the burden is on Applicant to show that the prior art composition would not constitute a cream.

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Claims 1-3,21,22 are rejected under 35 U.S.C. 103(a) as obvious over McAtee et al. (US Pat. 5,607,980) for the reasons set forth in the prior Office Action.

McAtee et al. was disclosed in the prior Office Action and the same is incorporated herein to avoid repetition.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

The recitation "about" in terms of amounts includes amounts above and below the specified amount. Applicant has made no showing that "about 23 %" does not include "about 20 %". As such, Applicant has not shown that the claim amendment avoids the prior art. Examiner notes that claims 5 and 7 are no longer part of this rejection.

Claims 1,2,21,22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wdowik (US Pat. 5,756,081).

Wdowik expressly discloses a shaving cream containing potassium stearate, sodium stearate, lauric acid diethanolamide (1.60%), mineral oil (17%), stearic acid (0.13%), coconut fatty acid (0.68%), glycerine (3.2%), PVP (0.12%), perfume, water (57.58%), propellant, particulate additive (3%) about 75 microns in size falling within the scope of applicant's claims (Column 6, lines 3-20).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978).

Claims 1-3,5,7,21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin (US Pat. 3,852,417) in view of Wdowik (5,756,081).

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McLaughlin discloses a shaving cream containing a water-soluble soap, a liquid oil material such as mineral oil, safflower oil, isopropyl myristate, and isopropyl palmitate, etc. and mixtures thereof in the range of from 12 to about 25%, with mineral oil being preferred, to provide a lubricating or emollient effect (Column 2, lines 18-68, Column 3, lines 1-25). It is disclosed that if a highly unsaturated triglyceride oil such as safflower oil is used the composition also preferably contains an antioxidant compound to prevent rancidity (Column 3, lines 12-14). It is disclosed that it is advantageous to include up to 8% by weight of glycerine or polyglycol humectant in the shaving cream composition (Column 4, lines 27-30). Various embodiments are disclosed containing mixtures of mineral oil and glycerine (including one which combined equals a total of 23.2% of the composition) or propylene glycol (Column 5, lines 10-68, Column 6, lines 31-68, Column 7, lines 1-25, Examples 1, 3-7, claims 1-8). It is disclosed that use of shaving cream of example 1 resulted in skin which was softened and moisturized (Column 5, lines 65-68).

Wdowik discloses the incorporation of insoluble particulate additives such as aluminum oxide, titanium oxide, calcium phosphate, calcium carbonate, etc., including mixtures thereof, having a practical range of about 10 to 500 microns and preferred range of 50 to 200 microns into shaving creams such as that disclosed in US Pat. 3,852,417 to McLaughlin to reduce undesired nicks and cuts, and improve post-shave smoothness (Column 3, lines 1-40, Column 4, lines 55-68, Columns 5, 6). It is disclosed that while 0.1% to 20% by weight of the insoluble particulate additives is adequate, greater than 20% by weight can be included and in thick pastes, solids and gels even as high as 90% or greater may be used to practice the invention (Column 3, lines 45-55). It is disclosed that the solid particulate additives also work to remove dirt, oils,

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stains and dead skin cells form the skin surface thereby improving the smoothness and cleanliness of post-shave skin surfaces (Column 3, lines 62-68, Column 4, lines 1-55). An embodiment is disclosed in the form of a shaving cream containing potassium stearate, sodium stearate, lauric acid diethanolamide (1.60%), mineral oil (17%), stearic acid (0.13%), coconut fatty acid (0.68%), glycerine (3.2%), PVP (0.12%), perfume, water (57.58%), propellant, particulate additive (3%) about 75 microns (Column 6, lines 3-20).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the use of aluminum oxide or amount of abrasive particles in the amount of 35% or more. However, the prior art amply suggests the same as it taught that the prior art compositions can contain more than 20% of said particles, including up to 90% and greater, and aluminum oxide is disclosed as a suitable insoluble particulate additive. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that the amounts of abrasive particles could be varied including to with the scope of the claimed amounts depending on the desired abrasiveness or scrubbing action desired and that various abrasive particles could be interchangeable used including aluminum oxide to reduce undesired nicks and cuts and improve post-shave skin smoothness.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 872-9306.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

FIC

December 8, 2004




Alton Bryon
Primary Examiner
A.U. 1616